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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,292	11/19/2001	Guo-Liang Yu	PF160D2	8411

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EXAMINER

TUNG, JOYCE

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 03/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/988,292

Applicant(s)  
Yu et al.

Examiner  
Joyce Tung

Art Unit  
1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-161 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-161 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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### DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1637.

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to an isolated polynucleotide, vector comprising the polynucleotide, host transfected with the vector and process for producing genetically engineering cells and a polypeptide from the host cells, classified in class 536, subclass 22.1.
  - II. Claims 8-9, drawn to a polypeptide, classified in class 530, subclass 350.
  - III. Claims 10, 19-43, 53-79, 89-115 and 125-152 drawn to an antibody against the polypeptide, classified in class 424, subclass 130.1.
  - IV. Claim 11, drawn to a compound which inhibits activation of the polypeptide, classified in class 422, subclass 79.
  - V. Claims 12-13, drawn to a method of treating a patient with the compound of claim 11 classified in class 435, subclass 174.
  - VI. Claim 14, drawn to a method for the treatment of a patient with the peptide of claim 8, classified in class 435, subclass 7.1.

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VII. Claims 15-18, drawn to a process for diagnosing a disorder of the colon in a host, classified in class 435, subclass 91.51.

VIII. Claims 44-52, 80-88, 116-124, 153-161 are drawn to a method of detecting CSG10 protein with antibody, classified in class 435, subclass 7.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-III and V-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used for example, Group I is drawn to polynucleotide which can be used in nucleic acid purification, Group II-III are drawn to peptide or antibody which can be used in protein purification.

3. Inventions Group I, and II-III are distinct because Group I is drawn to polynucleotide and Groups II-III are drawn to polypeptide or antibody. Polypeptides and nucleic acids have distinct chemical structures and physical properties, the former composed of amino acids and the latter composed of nucleotides. Further, they have distinct utilities, such as use of nucleic acids in hybridization and use of proteins for enzymatic function. Antibody is polypeptide, but it has special chemical structure. Therefore, the above inventions are novel and unobvious over each other.

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4. Inventions Groups V-VIII, are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, Group V is for treating a patient with a compound, Group VI is for treating a patient with an antibody, Group VII is for diagnosing a disorder of the colon in a host and Group VIII is for detecting CSG10 protein with antibody.

5. Group IV is distinct from any groups because Group IV is drawn a compound which can be nucleic acid or protein or any compound which inhibits activation of the polypeptide.

6. Group III, claims 10, 19-43, 53-79, 89-115 and 125-152 are generic to a plurality of disclosed patentably distinct species comprising:

Species A, Claim 10, drawn to an antibody against the polypeptide, classified in class 424, subclass 130.1.

Species B, claims 19-43, drawn to an antibody which binds to a protein selected from the protein as listed in claim 19(a)-(c), classified in class 424, subclass 130.1.

Species C, claims 53-79 and 89, drawn to an antibody by immunizing an animal with the protein selected from the protein as listed in claim 53(a)-(c), classified in class 424, subclass 130.1.

Species D, claims 90-115, drawn to an antibody which binds with the protein selected from the protein as listed in claim 90(a)-(c), classified in class 424, subclass 130.1.

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Species E, claims 125-129, drawn to an antibody produced by immunizing with the protein as listed in claim 125(a)-(c), classified in class 424, subclass 130.1.

Species F, claims 130-152, drawn to an antibody which binds to a protein which consists of the amino acid sequence of the full length CSG10 polypeptide, classified in class 424, subclass 130.1.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Group VIII, claims 44-52, 80-88, 116-124, 153-161 are drawn to a method of detecting CSG10 protein with antibody, classified in class 435, subclass 7.1 are generic to a plurality of disclosed patentably distinct species comprising:

Species A, claims 44-52 are drawn to a method of detecting CSG10 protein with antibody of Group III, Species B, classified in class 435, subclass 7.1.

Species B, claims 80-88, drawn to a method of detecting CSG10 protein with the antibody of Group III, Species C, classified in class 435, subclass 7.1.

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Species C, claims 116-124, drawn to a method of detecting CSG10 protein with the antibody of Group III, Species D, classified in class 435, subclass 7.1.

Species D, claims 153-161, drawn to a method of detecting CSG10 protein by the antibody of Group III, Species F, classified in class 435, subclass 7.1.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

12.. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

March 15, 2002

  
GARY BENZION, PH.D.  
SUPERVISORY PATENT EXAMINER  
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